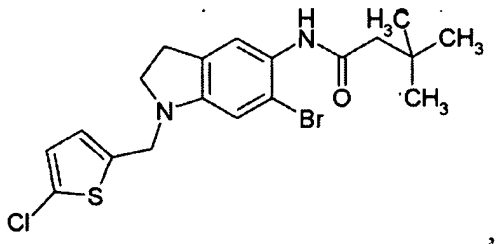
REMARKS

Claims 1-4, 6, 10, 12, 15, 17-18 and 21-23 will be pending in the present application. Claims 5, 7-9, 11, 13, 14, 16, 19, 20 and 24-37 are withdrawn from consideration. Claims 24-27 were previously withdrawn by Applicants. Claims 5, 7-9, 11, 13, 14, 16, 19 and 20 have been withdrawn by the Office for allegedly being drawn to non-elected species. *See* Office Action, page 3. Upon entry of this amendment, Claims 1-4, 6, 7, 10, 12, 15, 17-18 and 21-23 will be pending.

I. Elected and Examined Subject Matter

The United States Patent and Trademark Office ("the Office") has withdrawn from consideration claims 5, 7-9, 11, 13, 14, 16, 19, and 20, as a result of Applicants' alleged election. *See* page 3 of the Office Action. However, Applicants respectfully note that the alleged identified corresponding scope of the invention does not encompass Applicants' elected species – namely, N-[6-Bromo-1-(5-chlorothiophen-2-ylmethyl)-2,3-dihydro-1H-indol-5-yl]-3,3-dimethylbutyramide ("elected species"). The elected species:



with respect to its genus of formula I unmistakably includes when R^2 is halogen (specifically, Br, in this instance). Clearly, then, the elected and examined subject matter includes at least where R^2 is halogen, and not only where R^2 is hydrogen as the Office examined. *See id.* Thus, claim 7 should not be withdrawn in as far as R^2 is halogen, and Applicants respectfully request reconsideration thereof.

II. Claims are Not Obvious

The Office has rejected claims 1-4, 6, 10, 12, 15, 17-18 and 21-23 under 35 U.S.C. 103(a) for allegedly being unpatentable over U.S. Patent No. 7,084,176 by Morie et al. (hereinafter, "the '176 patent"). Applicants traverse the rejection and respectfully request it be reversed.

In order for a claimed invention to be made obvious, the teaching of a prior art reference or teachings of a combination of prior art references must be viewed in light of four factual inquiries:

(a) determining the scope and contents of the prior art;

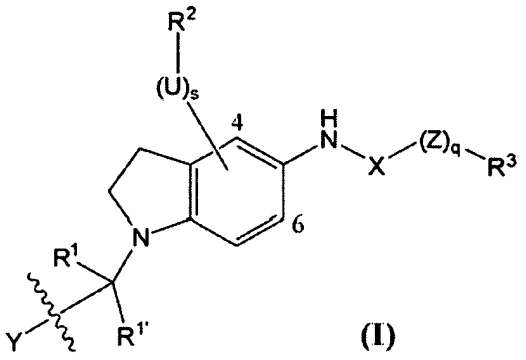
(b) ascertaining the differences between the prior art and the claims in issue;

(c) resolving the level of ordinary skill in the pertinent art; and

(d) evaluating evidence of secondary consideration.

See Graham v. John Deere, 383 U.S. I, 17-18, 148 USPQ 459,467 (1966). The Supreme Court affirmed the Graham analysis as the framework for determining obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007). Moreover, whether the reference(s) teach, suggest or motivate one of ordinary skill in the art to combine the reference(s) in a manner that achieves the claimed invention can be helpful in this determination for obviousness. *See e.g., In re Translogic Tech., Inc.* 540 F.3d 1249 (Fed. Cir. 2007).

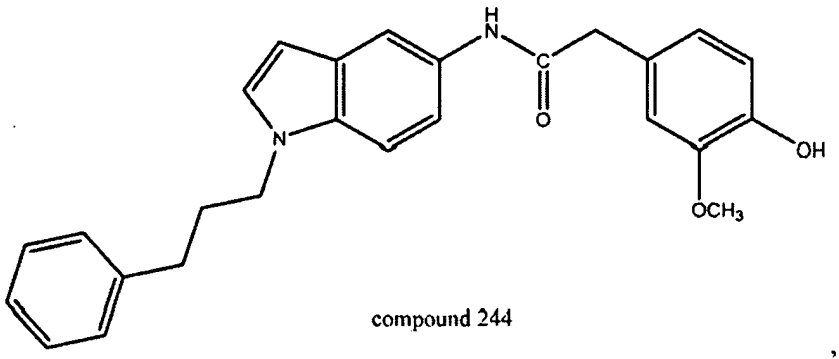
However, the '176 patent fails to make the present invention obvious. For example, amended claim 1 teaches indoline compounds of formula I:



(I)

where R^1, $R^{1'}$, R^2, R^3, U, X, Y, Z, q and s are as defined in the claims listing herein, of which the elected species, N-[6-Bromo-1-(5-chlorothiophen-2-ylmethyl)-2,3-dihydro-1H-indol-5-yl]-3,3-dimethylbutyramide, is one such compound.

By contrast, although the '176 patent specifically discloses the indole compound 244:



compound 244

it fails to teach or suggest an indoline compound, much less one like that of formula I of the present invention. *See e.g.*, col. 4, lines 57-59, col. 10, lines 58-60, col. 90, lines 6-8, and Examples 1-260. In fact, the '176 patent only teaches an indole or tetralone as the aromatic heterocyclic moiety of its compounds. *Id.*

Moreover, a particular object of the '176 patent is "to provide a novel N-arylphenylacetamide derivative being useful as an agent for treatment of pain and inflammation." *See* col. 3, lines 9-11; see also, col. 3, lines 23-33 and col. 4, lines 57-59. Thus, the '176 patent clearly teaches away from indoline compounds, as well as for their use in disorders responsive to an increased ion flow in a potassium channel (e.g., a seizure disorder and an anxiety disorder), unlike the present invention. *See e.g.*, amended claim 1 and page 54, line 5 through page 56, line 8 of the specification.

Indeed, by its silence regarding indoline-containing compounds, the '176 patent teaches away from the present invention because, in its single focus on indole or tetralone for the aromatic heterocyclic moiety of its compounds, the '176 patent fails to provide an apparent reason for one of ordinary skill in the art to modify its teaching to achieve the indoline compounds of amended claim 1.

With its rejection, the Office proffers that compound 244 of the '176 patent makes obvious the compounds of the present invention because the skilled artisan "would have been motivated to prepare a homolog of a compound having [a] '-(CH_2)-' linker between the indole ring and moiety **Y** in view of the '176 patent teaching a compound having [a] '-$(CH_2)_3$-' linker between the indole ring and moiety **Y**." *See* page 6 of the Office Action (emphasis in the

original). Along this line, the Office asserts that the requisite motivation to modify the non-indoline compounds of the '176 patent to achieve the indolines of the present invention "derives from the expectation that structurally similar compounds would possess similar activity (i.e., pharmacological use)." *Id.*

Yet the compounds of the present invention arguably are not homologs of the N-arylphenylacetamide derivatives of the '176 patent. The mere fact that compound 244 of the '176 patent and the compounds of the present invention contain an alkylene ($-(CH_2)_n-$) linker does not mean the compounds are homologues. Homologous compounds are compounds that are part of series, which have a corresponding general formula, in which there is similarity between compounds and a graded change in their physical properties. But, in this instance, the N-arylphenylacetamide derivatives of the '176 patent and the indolines of the present invention do not have a corresponding general formula. As previously discussed, the N-arylphenylacetamide derivatives of the '176 patent only provide compounds containing an indole or tetralone moiety, which comprises the benzene ring that is directly attached to the acetamide moiety, and further fails to suggest that the indole or tetralone moiety can be the indoline moiety of the indoline compounds of amended claim 1. Thus, the N-arylphenylacetamide derivatives of the '176 patent and the indolines of the present invention are not homologues.

Even if the Office maintains that compound 244 of the '176 patent is a homologue of the indolines of the present invention, Applicants respectfully remind the Office that the proper analysis under § 103 is of the prior art and the claimed invention "as a whole." *See e.g.*, In re Langer, 465 F.2d 896, 175 U.S.P.Q. 169 (C.C.P.A. 1972) (analyzing the invention as a whole prevented the structural similarity of the homologs from establishing a *prima facie* case of obviousness under the appropriate analysis). Thus, taken as whole, the '176 patent still fails to make the present invention obvious.

For example, as previously discussed, because the '176 patent is silent with regard to indoline compounds and their usefulness in a disorder responsive to an increased ion flow in a potassium channel, it does not provide any reasoning why the skilled artisan would modify aspect of its compounds, such as the aromatic heterocyclic moiety and length of the alkylene ($-(CH_2)_n-$) linker, so as to achieve the indolines of amended claim 1, much less for their use in

disorders such as anxiety, seizure, and neurodegenerative, *i.e.*, disorders responsive to an increased ion flow in a potassium channel. Also, the alleged homologous relationship based on an alkylene linker is nothing more than one fact of many relevant facts that must be considered when determining obviousness. Other relevant facts include that an indoline moiety is not taught or envisioned by the '176 patent, and that hindsight reconstruction during examination is improper. Only with hindsight and use of Applicants' own specification as a blueprint, would the skilled artisan be able to achieve – and more so be motivated to achieve – the indolines of amended claim 1 in view of the '176 patent.

Consequently, the claimed invention of amended claims 1 is unobvious over the '176 patent. Applicants respectfully request the rejection be reversed.

III. Claim Objection

The Office objects to claims 1-4, 6, 10, 12, 15, 17-18 and 21-23 for allegedly containing elected and non-elected subject matter. Because of the foregoing, Applicants believe the Office has not proven that the elected species and genus of amended claim 1 are not patentable; and therefore believe that the subject matter of claims 1-4, 6, 10, 12, 15, 17-18 and 21-23, should not be withdrawn but examined. Applicants respectfully request reconsideration accordingly.

IV. Conclusion

Applicants believe the claims are in condition for allowance, and therefore, earnestly solicit an early Notice of Allowance. The Office is requested to contact the undersigned if an interview would facilitate allowance of the claims.

The Commissioner is hereby authorized to charge any fee or underpayment thereof, or credit any overpayment, to deposit account no. 503201.

Respectfully submitted,

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